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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,225	10/25/2001	Jeffrey G. Wiley	10016469-1	8739

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

EHICHIOYA, FRED I

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/033,225		WILEY, JEFFREY G.	
	Examiner		Art Unit	
	Fred I. Ehichioya		2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4 - 12, 14 - 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4 - 12, 14 - 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant arguments, with respect to claims 1 – 27, filed June 23, 2004 have been fully considered but they are not persuasive for the following reasons.

Applicant argues:

(a) Czyszczewski does not discuss network addresses of services (e.g., databases) that may be identified by MFDs and specified by the user. The “network addresses of services (e.g., databases) that may be identified by MFDs and specified by the user” in the present application and claims has specifically different meaning (Page 11, Paragraph 2).

(b) Stevenson does not discuss or suggest that a user might specify – “at said multifunction device” –a path to a remote storage device (Page 12, paragraph 3).

Regarding argument (a): It is respectfully noted that Applicant's arguments appear incommensurate in scope with the limitations of representative claims 1. In particular, the examiner does not see where the “network addresses of services (e.g., databases) that may be identified by MFDs and specified by the user”. The passage in Czyszczewski relied upon the Office action for the rejection refers to “establishing a link between said multifunction device and a user-specified remote storage device having said data operatively associated therewith” of Czyszczewski is not like the “network

addresses of services (e.g., databases) that may be identified by MFDs and specified by the user” of the present invention.

It is noted that Czysteczewski shows in column 2, line 3 - 6, "connectivity between the multifunction device which is analogous to establishing a link between said multifunction device and a user-specified remote storage device having said data operatively associated therewith, therefore the claimed limitation is rendered obvious over the art of record at the present time.

Regarding argument (b): Examiner respectfully disagrees with the applicant because this claim limitation is not defined in the specification and therefore the rejection is based on **35 USC § 112** as discussed below.

2. Examiner respectfully disagrees with all of the allegations as argued. Examiner, in his previous office action, pointed out exact locations in the cited prior art.

In view of the above, the examiner contends that all limitations as recited in the claims have been addressed in this Action. For the above reasons, Examiner believed that rejection of the last Office action was proper.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no mention as to identifying said user-specified remote storage device based at least in part on a path thereto specified by a user at said multifunction device. Identifying said user-specified remote storage device based at least in part on a path is not disclosed, and therefore is not enabling to one of ordinary skill in the art.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 12 are rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 12, the term "Identifying said user-specified remote storage device based at least in part on a path" in claims 1 and 12 is relative which renders the claim indefinite. The term "Identifying said user-specified remote storage device based at least in part on a path" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Regarding claims 4 - 11, these claims depend from claim 1 and claims 14 - 20 depend from claim 12; therefore inherit their deficiencies respectively.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4 - 12, and 14 - 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S Patent 6,577,907 issued to Joseph Stanley Czystczewski et al. (hereinafter "Czystczewski") in view of U.S. Patent 6,321,308 issued to Dan Arnon et al (hereinafter "Arnon").

Regarding claim 1, Czystczewski teaches a method for providing access from a multifunction device to data operatively associated with a user-specified remote storage device, comprising:

establishing a link between said multifunction device and the user-specified remote storage device having said data operatively associated therewith (see column 2, lines 3 - 6); and

accessing said data operatively associated with said user-specified remote storage device from said multifunction device over said link established therebetween (see column 3, lines 50 - 60).

Czyszczewski does not explicitly teach identifying said user-specified remote storage device based at least in part on a path thereto specified by a user at said multifunction device.

Arnon teaches identifying said user-specified remote storage device is based at least in part on a path thereto specified by a user at said multifunction device (see column 4, lines 60 – 66).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Arnon with the teaching of Czyszczewski to provide a method and apparatus for improving performance of data transactions associated with several devices connected via a bus or network. The motivation is that this system provides queuing scheme, which allows for a high degree of parallelism while maintaining validity of storage system.

Regarding claim 4, Czyszczewski teaches identifying said user-specified remote storage device is based at least in part on a user profile (see column 3, lines 50 – 55).

Regarding claim 5, Czyszczewski teaches converting a document to electronic format at said multifunction device (see column 2, lines 65 – 67); and

combining said document in electronic format with said accessed data (see column 9, lines 3 – 7).

Regarding claim 6, Czyszczewski teaches combining said accessed data with an electronic document generated at said multifunction device (see column 11, lines 12 – 19); and

sending said combined electronic document and accessed data from said multifunction device to a network destination (see column 3, lines 1 – 7 and column 7, lines 12 – 25).

Regarding claim 7, Czyszczewski teaches accessing said data is from an address book operatively associated with said user-specified remote storage device (see column 12, lines 8 – 14).

Regarding claim 8, Czyszczewski teaches identifying a network destination for an electronic document generated at said multifunction device based on said data accessed from said address book (see column 14, lines 15 – 20).

Regarding claim 9, Czyszczewski teaches editing an entry in said address book operatively associated with said user-specified remote storage device from said multifunction device (see column 6, lines 50 – 67).

Regarding claim 10, Czyszczewski teaches configuring said multifunction device before identifying said user-specified remote storage device (see column 3, lines 56 – 60).

Regarding claims 11 and 20, Czyszczewski teaches displaying at least a portion of said data at said multifunction device (see column 10, lines 21 - 24).

Regarding claim 12, Czyszczewski teaches a method for accessing user-requested data from a configured multifunction device, comprising:

retrieving said user-requested data operatively associated with said remote storage device from said configured multifunction device (see column 10, lines 21 – 27).

Czyszczewski does not explicitly teach identifying a remote storage device having said user-requested data operatively associated therewith based at least in part on a path for said remote storage device specified by a user at said configured multifunction device.

Arnon teaches teach identifying a remote storage device having said user-requested data operatively associated therewith based at least in part on a path for said remote storage device specified by a user at said configured multifunction device (see column 4, lines 60 – 66).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Arnon with the teaching of Czyszczewski to provide a method and apparatus for improving performance of data transactions associated with several devices connected via a bus or network. The motivation is that this system provides queuing scheme, which allows for a high degree of parallelism while maintaining validity of storage system.

Regarding claim 14, Czyszczewski teaches identifying said remote storage device is based at least in part on a user profile (see column 3, lines 50 – 55).

Regarding claim 15, Czyszczewski teaches converting a document to electronic format at said configured multifunction device (see column 2, lines 65 – 67); and combining said document in electronic format with said retrieved user-requested data (see column 9, lines 3 – 7).

Regarding claim 16, Czyszczewski teaches combining said retrieved user-requested data with an electronic document generated at said configured multifunction device (see column 11, lines 12 – 19); and

sending said combined electronic document and retrieved user-requested data from said configured multifunction device to a network destination (see column 3, lines 1 – 7 and column 7, lines 12 – 25).

Regarding claim 17, Czyszczewski teaches retrieved said user-requested data is from an address book operatively associated with said remote storage device (see column 12, lines 8 – 14).

Regarding claim 18, Czyszczewski teaches identifying a network destination for an electronic document generated at said configured multifunction device based on said user-requested data retrieved from said address book (see column 14, lines 15 – 20).

Regarding claim 19, Czyszczewski teaches editing an entry in said address book operatively associated with said remote storage device from said multifunction device (see column 6, lines 50 – 67).

Regarding claim 21, Czyszczewski teaches a multifunction device comprising:
computer-readable media operatively associated with said multifunction device and having computer-readable program code thereon including program code for identifying data operatively associated with a user-specified remote storage device (see column 9, lines 38 – 49 and column 10, lines 21 - 27); and

program code for accessing said data operatively associated with said user-specified remote storage device from said multifunction device (see column 10, lines 28 – 47).

Czyszczewski does not explicitly teach identifying data operatively associated with a user-specified remote storage device (see column 6, lines 46 – 51).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Arnon with the teaching of Czyszczewski to provide a method and apparatus for improving performance of data transactions associated with several devices connected via a bus or network. The motivation is that this system provides queuing scheme, which allows for a high degree of parallelism while maintaining validity of storage system.

Regarding claim 22, Czyszczewski teaches said data is an address book (see column 12, lines 8 – 14).

Regarding claim 23, Czyszczewski teaches program code for retrieving an entry from said address book, said entry identifying a network destination (see column 12, lines 8 – 23);

program code for associating said entry from said address book with an electronic document at said multifunction device (see column 7, lines 14 – 26); and

program code for sending said electronic document to said network destination identified by said entry from said address book (see column 7, lines 16 – 22).

Regarding claim 24, Czyszczewski teaches said data is a document in electronic format (see column 2, lines 65 – 67).

Regarding claim 25, Czyszczewski teaches program code for sending a document in electronic format from said multifunction device to a network destination (see column 3, lines 1 – 7 and column 7, lines 12 – 25).

Regarding claim 26, Czyszczewski teaches program code for combining a document in electronic format with a document image at said multifunction device (see column 9, lines 3 – 7);

program code for sending said combination of said document in electronic format and said document image from said multifunction device to a network destination (see column 5, lines 30 – 40).

Regarding claim 27, Czyszczewski teaches said user-specified remote device is another multifunction device (see column 7, lines 26 – 40).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2162


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 571-272-4034. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fred I. Ehichioya
Patent Examiner
Art Unit 2162

November 2, 2004


SHAHID ALAM
PRIMARY EXAMINER